

REMARKS

Claims 1-5, 10-19, 24-30, and 39 are currently pending and under examination. Claims 1, 10, 15, 24, and 39 have been amended. Support for the amendments is found at page 23, lines 16-17 of the specification, among other places. Unless otherwise noted, the claims have been cancelled or amended to further Applicant's business interests and the prosecution of the present application in a manner consistent with the PTO's Patent Business Goals (PBG; 65 Fed. Reg. 54603 (September 8, 2000), and not in acquiescence to the Examiner's arguments and while reserving the right to prosecute the original (or similar) claims in the future. None of the claim amendments made herein are intended to narrow the scope of any of the amended claims within the meaning of *Festo Corp. v. Shokestu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) or related cases.

The Examiner has objected to the specification as containing several informalities. These have been corrected per the Examiner's suggestions.

Claims 1-5, 10-19, 24-30, and 39 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious under U.S. 5,760,082 to Cook et al., U.S. 6,159,525 to Lievense et al. in view of WO 97/18320 to Cain et al., Remmereit (6,034,132) and the Applicant's alleged admission. Claims 10 - 19 and 24 - 34 are also rejected under the judicially created doctrine of obviousness-type double patenting. Applicants will submit a terminal disclaimer upon resolution of the §103(a) rejection.

A *prima facie* case of obviousness requires the Examiner to provide a reference(s) which (a) discloses all of the elements of the claimed invention, (b) suggests or motivates one skilled in the art to combine the claimed elements to produce the claimed combination, and (c) provides a reasonable expectation of success should the claimed combination be carried out. Failure to establish any one of these three requirements precludes a finding of a *prima facie* case of obviousness and without more entitles the Applicants to allowance of the claims in issue.¹ In addressing this rejection, Applicants focus on the independent claims since the non-obviousness of independent claims necessarily leads to the non-obviousness of claims dependent thereon.²

¹ See, e.g., *Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990).

² §MPEP 2143.03.

The Examiner admits that the “primary references do not teach expressly the employment of a combination of antioxidant and metal (oxidant) chelator, such as ascorbic acid and lecithin, or the use of a commercial antioxidant product, Controx, or particularly point out the amount of VOC.” It is precisely the combination which is claimed – thus Applicants question how references which do not teach or suggest such a combination can render the claims obvious. In a nutshell, there is no *prima facie* case of obviousness because none of the cited references teach combining the claimed ingredients to stabilize CLA. Thus, all of the elements of the claim are not taught or suggested by the prior art.

The Examiner attempts to gloss over this deficiency by arguing: “As to the employment of two of the known antioxidants, note, it is *prima facie* obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for the very same purpose; idea of combining them flows logically from their having been individually taught in the prior art, thus, the claimed invention which is a combination of two known antioxidants sets forth *prima facie* obvious subject matter.” The Examiner then cites *In re Kerkhoven*, 205 USPQ 1069 as support for this proposition.

The Examiner’s analysis has a major flaw. The claimed invention is not simply “a combination of two known antioxidants.” It is the use of antioxidants to stabilize a particular compound – CLA. Thus, the holding of *Kerkhoven* does not apply to the claimed invention. This flaw is highlighted by the Examiner’s admission that the prior art does not teach a combination of chelators and antioxidants to stabilize CLA. Absent such a description, the claims cannot be obvious. If one followed the prior art, they would use either a chelator or antioxidant, not both. Thus, the prior art teaches away from the use of a combination of chelators and antioxidants.

Moreover, the Examiner’s response ignores the established rule that “[i]t should not be necessary . . . to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified.” (*In re Sponnable*, 405 F.2d 578, 585 (C.C.P.A. 1969); *In re Kosei Nomiya et al.*, 509 F.2d 566, 571 (C.C.P.A. 1975)). As detailed in the Saebo Declaration, the Applicants recognized the problem that the use of antioxidants such as ascorbic acid was insufficient to prevent the formation of undesirable products in CLA compositions. Applicants recognized that the source of this problem was CLA’s susceptibility to breakdown in the presence of metal ions.

(Specification, *p.* 24, *ll.* 20-25). This “source of the problem” had gone unrecognized in the prior art. Thus, it is no surprise that the prior art did not teach the combination of the claimed ingredients. Thus, according to the rule of *In re Sponnable*, the claimed invention is patentable even if the remedy was obvious once the source of the problem was identified. Indeed, the failure of the prior art to recognize or suggest a solution to the problem of VOC formation in CLA compositions strongly supports the patentability of the claimed invention.

Finally, the Examiner argues that Applicants have made an “unexpected result” argument; that 1.132 Declarations must compare the claimed subject matter with the closest prior art; and that the evidence must be commensurate in scope with the claimed invention. These arguments are misplaced.

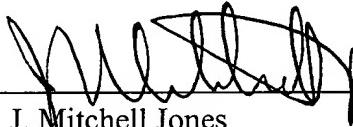
First, the Declaration is not solely directed to evidence of unexpected results. Instead, the Declaration is intended to provide evidence supporting the facts that a) prior art methods of stabilization with just one compound such as ascorbic acid are insufficient (i.e., there is a problem); b) that applicant’s solved the problem; and c) that the prior art compositions necessarily contained high levels of VOCs because the problem had not been solved. The Examiner’s attempt to minimize the value of the Declaration as evidence because it is allegedly directed to unexpected results is misguided. Applicants note that the section of the MPEP upon which the Examiner relies (716.02(3)) is directly only to evidence of unexpected results, not to 1.132 Declarations in general. Because the Declaration is not solely directed to unexpected results, and instead contains other relevant, factual information, the Examiner must consider and give weight to the factual evidence contained in the Declaration instead of minimizing it. In any event, a comparison with the closest prior art is provided because the closest prior art does utilize ascorbic acid, which is the control treatment in the experiments described in the Declaration.

The Examiner also argues that the Declaration is not commensurate with the scope of the claims. This argument is also misguided. The claims are directed in part to mixtures of free radical scavengers and metal chelators and the Declaration describes the use of precisely such compositions. Thus the Declaration does directly support the claimed subject matter. Nothing more is needed or required by the law. Again, the Examiner is urged to address the factual evidence in the Declaration, not attempt to avoid it through improper characterization.

C O N C L U S I O N

All grounds of rejection and objection of the Office Action of January 12, 2005 having been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the invention as claimed fully meets all requirements for patentability and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

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